

Patent No.: 7,427,403

Art Unit: 1646

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Dated: November 21, 2008

Signature: /Jill Gorny Sloper, Esq./
(Jill Gorny Sloper, Esq.)

Docket No.: BGN-B191CPUSDV
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Jeffrey L. Browning *et al.*

Application No.: 10/077,406

Confirmation No.: 4141

Filed: February 15, 2002

Art Unit: 1646

For: Methods for Inhibiting Lymphotoxin-Beta
Receptor Signalling

Examiner: E. B. O'Hara

MS Patent Extension
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

STATEMENT UNDER 37 CFR § 1.702(b)(2)

Dear Sir:

1. This statement is respectfully submitted in support of the “Application for Patent Term Adjustment Including Request for Reconsideration Under 37 CFR §1.705(b) and (d)” for the above-referenced patent. In view of the following, it is respectfully requested that Patentees be granted a patent term adjustment of **1607 days**.
2. The patent term adjustment per the “Determination of Patent Term Adjustment Under 35 U.S.C. §154(b)” as shown on the face of the issued patent is 1009 days. This determination of 1009 days is in error for the reasons discussed below.
3. The factual bases for the above adjustment are set forth as follows:

A. Examination Delays Pursuant to 37 CFR §1.702 and §1.703

Pursuant to 37 CFR §1.703(f), the period of adjustment of the term of the patent under §1.702 is the sum of the periods of examination delay calculated under subparagraphs (a)-(e), to the extent that such periods are not overlapping, less the sum of the periods calculated under §1.704 (the period of Applicant Delay). In the above-referenced patent, Patentees are entitled to a period of examination delay equal to the sum of the periods of delay under §1.703(a) and (b) for the reasons set forth below.

(i) “14 Month Delay” Pursuant to §1.703(a)(1)

In accordance 37 CFR §1.703(a)(1), Patentees are entitled to a period of patent term adjustment due to the failure by the Office to mail an action under 35 U.S.C. §132 not later than 14 months (*i.e.*, by April 15, 2005) after the actual filing date (hereinafter “14 Month Delay”). As shown on the Office’s PTA Calculation Sheet (see Exhibit A), the Office failed to mail an action under 35 U.S.C. §132 (a Restriction Requirement) until June 23, 2005. Patentees are entitled to a period of patent term adjustment beginning on the day after the date that is 14 months (*i.e.*, April 15, 2003) after the date on which the above-referenced patent was filed under 35 U.S.C. §111(a), and ending on the date of mailing of an action under 35 U.S.C. §132, *i.e.*, June 23, 2005. Accordingly, the period of patent term adjustment due to the 14 Month Delay by the Office is 800 days, which is in agreement with the period calculated by the Office on the PTA Calculation Sheet (Exhibit A).

(ii) “Three Years Delay” Pursuant to 37 CFR §1.703(b)

Patentees respectfully submit that the Office did not comply with the requirement of 35 U.S.C. §154(b) and 37 CFR §1.702(b), which requires issuance of a patent within 3 years after the date on which the patent was filed under 35 U.S.C. §111(a). However, since the exclusionary period for appellate review set forth in 37 CFR §1.702(b)(4) applies to the instant patent, the number of days in the period beginning on the date on which Patentees first filed a Notice of Appeal (September 24, 2007) and ending on the mailing date of a Notice of Allowance (December 6, 2007) is excluded from the period of Three Years Delay. Therefore, in accordance with 37 CFR §1.703, Patentees are entitled to a period of patent term adjustment beginning on February 16, 2005 (the day after the date that is three years after the date on which the above-

referenced patent was filed under 35 U.S.C. §111(a)) and ending on the date which Patentees filed a Notice of Appeal (September 24, 2007), which amounts to 950 days of patent term adjustment. Patentees are also entitled to a period of patent term adjustment beginning on the day after the day the Notice of Allowance issued (December 6, 2007) and ending on the date of issuance of the patent (September 23, 2008), which amounts to 292 days of patent term adjustment. Accordingly, the total period of this delay is 1242 days.

(iii) “4 Month PTO Issue of Patent Delay” Pursuant to 37 CFR §1.702(a)(4)

The Office did not comply with the requirement of 37 CFR §1.702(a)(4), which requires issuance of a patent not later than four months after the date on which the issue fee was paid under 35 USC 151 and all outstanding requirements were satisfied. As shown on the Office’s PTA Calculation Sheet (see Exhibit A), the Office failed to issue a patent until September 23, 2008. Therefore, Patentees are entitled to a period of patent term adjustment beginning on the day after the date that is 4 months after the date on which the issue fee was paid, *i.e.*, July 5, 2008, and ending on the date the patent issued, *i.e.*, September 23, 2008. Accordingly, the period of patent term adjustment due to the 14 Month Delay by the Office is 81 days, which is in agreement with the period calculated by the Office on the PTA Calculation Sheet (Exhibit A).

(iv) Total Examination Delay Pursuant to 37 CFR §1.703(f)

As set forth in 37 CFR §1.703(f), the period of examination delay based on the grounds set forth in 37 CFR §1.702 is the sum of the period of 14 Month Delay (800 days), the maximum period of Three Years Delay (1242 days), and 4 Month PTO Issue of Patent Delay (81 days), or 2123 days, to the extent these periods of delay are not overlapping. As the period of 14 Month Delay ended on June 23, 2005, which is after the first day of the period of Three Years Delay, *i.e.*, February 15, 2005, Patentees submit that these periods are overlapping by 128 days. Additionally, the entire period of the 4 Month PTO Issue of Patent Delay (*i.e.*, 81 days) overlaps with a portion of the Three Years Delay. Accordingly, the sum of the total examination delays (2123) is reduced by the total periods of overlap (209 days), resulting in a total examination delay of 1914 days.

B. “Applicant Delay” Pursuant to 37 CFR §1.704

Pursuant to 37 CFR §1.704 the period of adjustment of the term of the patent due to examination delay is reduced by the period of Applicant Delay. As shown in the PTO’s Patent Term Adjustment calculation (Exhibit A), the Office has calculated a period of Applicant Delay of 240 days. Applicants respectfully submit that the correct period of Applicant Delay is 307 days and seek correction based on the following remarks.

(i) Two Month Applicant Response to Notice of Abandonment

Applicants respectfully submit that a period of Applicant Delay of 67 days accrued for the delayed submission of a Petition to Revive Application Unintentionally Abandoned on May 27, 2004. Therefore, pursuant to 37 CFR §1.704(c)(4), the period of adjustment shall be reduced by the number of days beginning on the day after the date that is 2 months after the mailing date of a Notice of Abandonment (*i.e.*, January 22, 2004) and ending on the date that the Petition was filed (*i.e.*, May 27, 2004), or 67 days. This is consistent with the “Adjustment of PTA Calculation by PTO” dated August 13, 2008 on the PTA Sheet (Exhibit A) from the Office. Accordingly, this 67 day period should be considered an Applicant Delay and should be added to the period of delay by Applicants.

(ii) Reply Having Omission

Applicants respectfully submit that an additional period of Applicant Delay of 32 days accrued for the submission of a Non-Responsive Amendment on July 21, 2005. This Non-Responsive Amendment is considered a “reply having an omission.” Therefore, pursuant to 37 CFR §1.704(c)(7), the period of adjustment shall be reduced by the number of days beginning on the day after the date the reply having an omission was filed (*i.e.*, July 22, 2005) and ending on the date that the reply correcting the omission was filed (*i.e.*, August 22, 2005), or 32 days. This is consistent with the PTA Sheet (Exhibit A) from the Office. Accordingly, this 32 day period should be considered an Applicant Delay and should be added to the period of delay by Applicants.

(iii) Applicant Delay for Responding to Non-Final Action Dated December 9, 2005

Applicants respectfully submit that an additional period of Applicant Delay of 92 days accrued for the delayed filing of an Amendment and Response on June 9, 2006. This is

consistent with the PTA Sheet (Exhibit A) from the Office. Accordingly, pursuant to 37 CFR §1.704(b), this 92 day period should be considered an Applicant Delay and should be added to the period of delay by Applicants.

(iv) Applicant Delay for Responding to Non-Final Action Dated August 23, 2006

Applicants respectfully submit that an additional period of Applicant Delay of **22 days** accrued for the delayed filing of an Amendment and Response on December 15, 2006. This is consistent with the PTA Sheet (Exhibit A) from the Office. Accordingly, pursuant to 37 CFR §1.704(b), this 22 day period should be considered an Applicant Delay and should be added to the period of delay by Applicants.

(v) Applicant Delay for Responding to Final Action Dated March 22, 2007

Applicants respectfully submit that an additional period of Applicant Delay of **94 days** accrued for the delayed filing of a Notice of Appeal on September 24, 2007. This is consistent with the PTA Sheet (Exhibit A) from the Office. Accordingly, pursuant to 37 CFR §1.704(b), this 94 day period should be considered an Applicant Delay and should be added to the period of delay by Applicants.

(vi) Calculation of the Total Period of Applicant Delay

In view of the above, Applicants have calculated a total period of Applicant Delay of **307 days** which is the sum of the following Applicant Delays: (i) the 67 day period; (ii) the 32 day period; (iii) the 92 day period; (iii) the 22 day period; and (iv) the 94 day period. Applicants respectfully submit that the correct period of Applicant Delay is **307 days, not 240 days**, and request appropriate correction by the Office.

C. Calculation of Correct Patent Term Adjustment Pursuant to 37 CFR §1.702(f)

As set forth in 37 CFR §1.703(f), Patentees are entitled to a period of patent term adjustment equal to the period of examination delays reduced by the period of Applicant Delay. Therefore, Patentees submit that the correct patent term adjustment for the above-referenced patent is **1607 days**, which is the difference between the total period of examination delay (1914 days) and the Applicant Delay (307 days).

4. In accordance with 37 CFR§1.705(b)(2)(iii), Patentees submit that this patent is not subject to a terminal disclaimer.

In view of the foregoing, it is respectfully requested that this Patent for Patent Term Adjustment be favorably considered and that a corrected Determination of Patent Term Adjustment be issued to reflect a patent term adjustment of **1607 days**.

Dated: November 21, 2008

Respectfully submitted,

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